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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,780	12/28/2004	Tomoyuki Asano	262954US6PCT	7690
22850 7590 11/12/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER NILFOROUSH, MOHAMMAD A	
			ART UNIT 3685	PAPER NUMBER
			NOTIFICATION DATE 11/12/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/517,780	<b>Applicant(s)</b> ASANO, TOMOYUKI	
	<b>Examiner</b> MOHAMMAD NILFOROUSH	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 5-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/28/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. The amendment filed 14 October 2008 is acknowledged.
2. Claims 1-36 are pending.
3. Claims 1-4 and 34-36 have been examined.
4. This Office action is given Paper No. 20081103 for reference purposes only.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-2, 4, and 34-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case, claim 1 is directed to "A data processing method". As the claims are not sufficiently tied to an apparatus, such as a computer, beyond a nominal

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recitation, and/or do not transform the underlying subject matter to a different state the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101.

Claims 2 and 34-36 are also rejected as each depends from claim 1.

8. Claim 4 is directed to "A data processing apparatus". Specifically, Claim 4 recites "a first unit" and "a second unit". However, this is merely software, and it has been held that software without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2 and 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 2 recites "generating a signature data...using a first data...said first data including...a predetermined second data". The claim further recites "generating a second data..." It is unclear to one of ordinary skill whether "a predetermined second data" and "a second data" refer to two different pieces of data or to the same piece of data. Further, if they refer to the same item of data, it is unclear how the "second data" can be used before being generated. For purposes of examination, Examiner assumed

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"a predetermined second data" and "a second data" refer to the same data and that this data existed prior to the generation of the signature data and was later re-generated based on the signature data. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

12. Claim 4 recites the limitation "said first means" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-4 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Harrison (US Patent No. 7,194,636).

15. Regarding claims 1, 3, and 4, Harrison discloses a data processing method, apparatus, and computer readable medium with instructions for identifying a plurality of recording media, comprising:

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- generating a plurality of identification data for identifying said plurality of recording media, said generating including
  - generating a plurality of different signature data using secret key data of a management side (Col. 5, ll. 20-34; Col. 5, l. 59 to Col. 6, l. 6);
  - assigning one of said plurality of identification data to a recording media of said plurality of recording media (Col. 5, ll. 26-34; Col. 5, l. 66 to Col. 6, l. 6).

16. Regarding claim 2, Harrison discloses a data processing method as set forth in claim 1, the method further comprising:

- generating a signature data of said plurality of signature data using a first data, said first data including said secret key data and a predetermined second data (Col. 5, ll. 26-34; Col. 5, l. 59 to Col. 6, l. 6, second data is unencrypted digest);
- generating a second data using a public key data corresponding to said secret key data and said signature data of said plurality of signature data, wherein said identification data includes a signature data of said plurality of signature data and said second data, said second data corresponding to said signature data (Paragraphs Col. 5, ll. 35-42; Col. 6, ll. 17-27).

17. Regarding claim 34, Harrison discloses verifying legitimacy of said identification data using a result of comparing said first data to said second data (Col. 5, ll. 40-42; Col. 6, ll. 17-24).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Best (US Patent No. 6,966,837).

20. Regarding claims 35 and 36, Harrison further discloses refusing to access data when it is determined that a medium is not authorized (Col. 6, ll. **25-27**) as well as writing data to an authorized recording media that has an identification data which is verified (Col. 4, ll. **14-17**; Col. 5, ll. **20-25**; **32-34**).

Harrison does not specifically disclose generating an identification revocation list, wherein said identification revocation list includes identification data corresponding to an unauthorized recording media. Nor does Harrison specifically disclose that encrypted content data is written to an authorized recording media that has an identification data that is not generated in said generating an identification revocation list.

Best discloses generating an identification revocation list, wherein said identification revocation list includes identification data corresponding to an unauthorized recording media (Col. 12, ll. **12-19**). Best further discloses that each produced disk has a different, unique serial number (Col. 12, ll. **57-61**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Harrison to include an identification

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revocation list and generating unique identification data for newly created disks as disclosed in Best as this is a predictable result of creating disks with verified and non-revoked identification data for a system that will only access disks with verified and non-revoked identification data (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD NILFOROUSH whose telephone number is (571)270-5298. The examiner can normally be reached on Monday-Thursday 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. N./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685